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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,545	12/21/2001	Norman Ken Ouchi	Solectron 721	7992
Robert Moll 1173 St. Charles Court Los Altos, CA 94024			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/037,545

Applicant(s)

OUCHI ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-8 and 31-38 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 March 2007 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-8 and 31-38 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues that "Project 2000" did not teach or suggest the recited steps of comparing a step field of an email with a route, define the next email address based on the comparison, updating the email address to the next email address and updating the step field to the next step. The Examiner respectfully does not agree. As shown previously, "Project 2000" expressly disclosed exchanging emails in an ordered circular

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pattern between users. The claims recites a route as being a "step-by-step" sequence of email addresses and that the next email address is determined based on comparing a step field with the route and defining the email address to be the next email address and updating the step field to the next step. The Examiner submits that these recited steps are expressly and inherently taught within the reference. The Examiner recognizes that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See MPEP 2112 and *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner submits that the teachings of "Project 2000" are substantially identical to the claimed invention. The Examiner submits that the claimed "route" is the "routing slip" as disclosed in "Project 2000" and that the "routing slip" is referred to when determining the next email address to define and update so that the next recipient can receive the email in the order specified by the "routing slip". Although "Project 2000" did not expressly recite a "step field" which, in view of the claim language, is used to denote what "step" in the route sequence the system is currently in and what its associated email address is. The Examiner contends that

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such a "step field" is inherent since, as explained previously, "Project 2000" discloses that the emails are sent in the order specified in the routing slip and, therefore, inherently perform the functions of the step field, since the system of "Project 2000" would NOT be able to function if it did not have any idea what current step within the routing slip and/or its associated email address so that the invention would operate as intended and disclosed. Therefore, the Examiner submits a reasonable rationale that "Project 2000" does in fact meet the limitations of the claimed invention.

It is submitted that the "Project 2000" reference taught a workflow system that is substantially identical to the claimed invention in the respect as described above and the Examiner has presented reasoning tending to show how some of the features of "Project 2000" are inherent. The Applicant is requested to provide proof that the prior art does not necessarily or inherently possess these characteristics of the claimed invention. See MPEP 2112.

The Applicant also argues that claims 1-8 as amended have support within the grandparent application 08/901,539. The Examiner agrees that the currently presented claims 1-8 do have such priority. Therefore, the rejections based on "Project 2000" are withdrawn. However, newly presented claims 32-38 do not have

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such support and only have priority to the filing date of the instant application, namely 21 December 2001.

Double Patenting

Claims 1-8 and 31 and also claims 33-35 and 37-38 by way of their dependency from claim 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,978,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites substantially the same limitations as in claim 2 of U.S. Patent No. 5,978,836. Further, claim 2 of the instant application recites substantially the same limitations as recited in claim 2 of U.S. Patent No. 5,978,836, however, claim 2 of the instant application does not recite a project to role to email address table which, in view of its lack of functional interrelationship with any element within the claim, would not be patentably distinct from claim 2 of U.S. Patent No. 5,978,836.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,125,075 to Goodale et al.

Regarding claim 1, Goodale discloses a workflow system, comprising:

a form route manager for receiving and sending email according to a route, the route comprising a step-by-step sequence of email addresses ("circulation list" or "route list"), wherein the form route manager includes:

an in-box adapted to receive email; a first sequencer adapted to as follows: compare a step field of the email with the route, define the next email address based on the compare, update the email address to the next email address, update the step field to the next step; and an out-box adapted to send email to the next email address. (column 1, line 67-column 2, line 20; column 4, lines 36-52)

Claim 32 and also claims 33-38 by way of their dependency from claim 32 are rejected under 35 U.S.C. 102(b) as being anticipated by "Teach Yourself Microsoft Project 2000 in 24 hours" ("Project 2000"). See also MPEP 2133.01 and *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

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Regarding claim 32, "Project 2000" discloses a workflow project management system, comprising a form route manager ("Messaging Application Programming Interface email system" which includes "Outlook" and "Exchange"; page 497, specifically the paragraph beginning "To communicate by email...") for receiving and sending email according to a route ("routing slip"), the route comprising a step-by-step sequence of email addresses (page 509, specifically "The initial sender designates an order in which the file is to be circulated..." and "Choose One after Another to have the file travel sequentially to each recipient"), and communicating with a project management system ("Project 2000"), wherein the form route manager includes an in-box adapted to receive email; a first sequencer adapted to as follows: compare a step field of the email with the route, define the next email address based on the compare, update the email address to the next email address, update the step field to the next step; and an out-box adapted to send mail to the next email address (page 509, "Using the Routing Slip", specifically "A routing slip allows you to circulate the same project file from one recipient to another...The initial sender designates an order in which the file is to be circulated...No recipient receives the file until the previous recipient; eventually, the file is sent back to the originator."), wherein

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the form route manager sends a message to the project management system at a project segment. (page 509-510, specifically "Using the Routing Slip", more specifically "eventually, the file is sent back to the originator")

Regarding claim 33, "Project 2000" discloses the workflow project management system of claim 32, wherein the message includes the time the message was sent (page 501, Figure 23.2, "Date").

Regarding claim 34, "Project 2000" discloses the workflow project management system of claim 32, wherein the message contains a segment identifier. ("Task Name"; page 501, Figure 23.2)

Regarding claim 35, "Project 2000" discloses the workflow project management system of claim 32, wherein a workflow route is associated with a project segment. (page 500, specifically "When team members have been assigned to tasks in a project, the team members must be notified of those assignments.")

Regarding claim 36, "Project 2000" discloses the workflow project management system of claim 32, wherein the project management system calculates the project schedule based on the message. (page 500, specifically "the manager opens the response and updates the project with the team member's response"; page 505, specifically "A workgroup member can send a status update

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on any task assigned to him or her, whether or not the manager has requested a TeamStatus report")

Regarding claim 37, "Project 2000" discloses the workflow project management system of claim 2, wherein the message is an email message. (page 497, specifically "Communicating with a Workgroup by Email")

Regarding claim 38, "Project 2000" discloses the workflow project management system of claim 32, wherein a workflow is initiated when a project segment is initiated or completed. (page 500, specifically "When team members have been assigned to tasks in a project, the team members must be notified of those assignments.")

Allowable Subject Matter

Claims 3 and 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

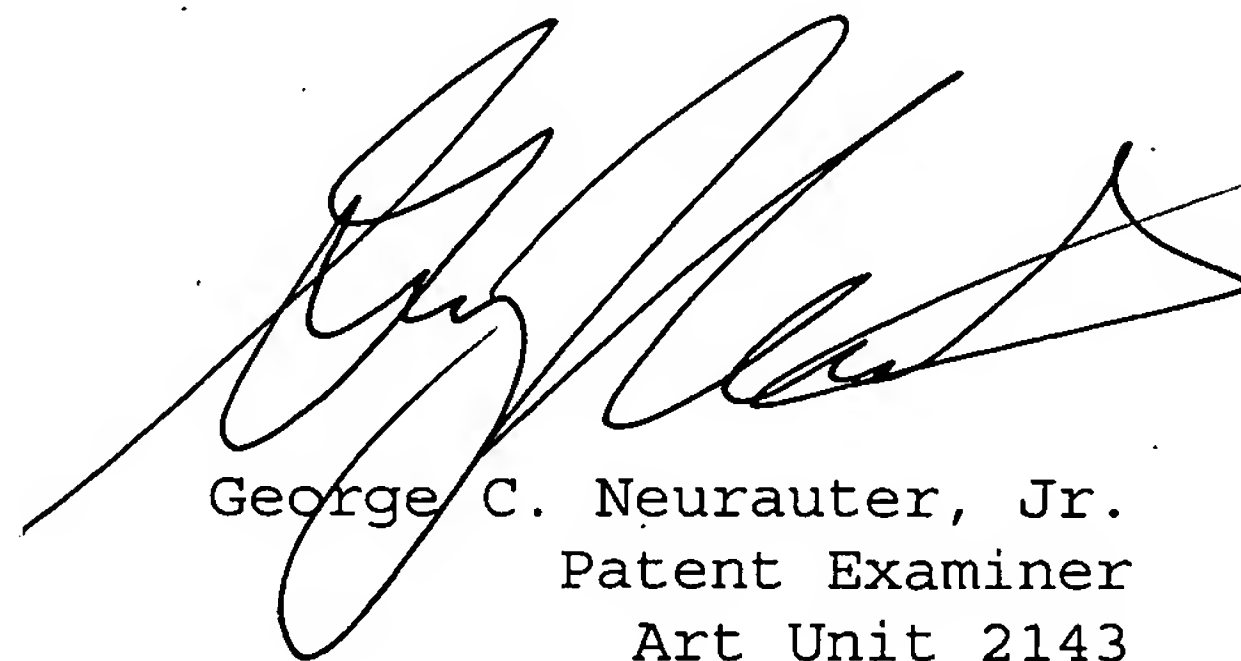
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neurauter, Jr.
Patent Examiner
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